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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,009	07/18/2003	Michael Novak	MS#303011.1 (5057)	4582

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SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER	
PADMANABHAN, KAVITA	
ART UNIT	**PAPER NUMBER**
2161	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,009	NOVAK ET AL.	
	Examiner	Art Unit	
	Kavita Padmanabhan	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7/18/03, 1/12/06,* 1/27/06, 2/23/06, 5/9/06
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-18 are pending.

2. Claims 19-22 have been canceled.

3. Claims 1-18 are rejected.

Election/Restrictions

4. Applicant's election without traverse of Group I, claims 1-18, in the reply filed on 4/7/06 is acknowledged.

Specification

5. The abstract of the disclosure is objected to because the phrase "according business rules" should be changed to --according to business rules-- at line 5 of the abstract. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities:

The word "can" should be removed after the word "metadata" at par [0004], line 4.

The word "fails" should be changed to --fail-- at and the word "a" should be removed at line 5 of par [0005].

Appropriate correction is required.

Claim Objections

7. **Claims 9 and 18** are objected to because of the following informalities: The acronyms should be spelled out in the claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. **Claims 2-7, 9, 11-15, and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "when the identified source does not define the property" in lines 2-3 of the claim. It is unclear what occurs when the identified source does define the property. **Claim 11** is similarly rejected.

Claims 9 and 18 contain acronyms, but it is unclear what these acronyms mean (for example, ASX and WSX).

Claim 3 recites the limitation "in the priority identified as including metadata defining the property" at lines 4-5 of the claim. It is unclear to the examiner what this means. **Claim 12** includes a similar limitation and is similarly rejected.

The examiner will apply prior art to this claim as best understood in light of the above rejection.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. **Claims 10-18** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **claims 10-18** recite a computer readable medium having instructions to perform a method, but the method does not appear to produce a useful, concrete, and tangible result.

Regarding **claim 10**, merely retrieving a property does not constitute a tangible result. **Claims 11-18** are similarly nonstatutory.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. **Claims 1, 3, 4, 10, 12, 13, and 16** are rejected under 35 U.S.C. 102(a) as being anticipated by **Applicant's Admitted Prior Art** (applicant's specification, par [0002] – par [0005], hereinafter "AAPA").

In regards to **claim 1**, **AAPA** teaches a method for retrieving a property of a media file being played via a media player, wherein the media file is retrieved from one of a plurality of media file sources, which are prioritized, comprising:

- identifying a source of the media file **(AAPA; par [0004], lines 1-2, 4; par [0005], lines 1-4; metadata for a particular media file can be retrieved from a plurality of sources, and one such source is identified in order to retrieve the file's latest metadata)**; and
- displaying the property as defined by metadata of the identified source of the media file **(AAPA; par [0005], lines 1-4)**.

In regards to **claim 3**, **AAPA** teaches the method of claim 1 further including:

- querying each of the media file sources according to their priority to identify a property for the media file defined by the metadata of the source of the media file **(AAPA; par [0004], lines 1-2, 4; par [0005], lines 1-4; since metadata can be retrieved from a**

plurality of sources, the sources are queried in order of their priority, i.e. last writer wins); and

- retrieving the property as defined by the metadata of a first source in the priority identified as including metadata defining the property **(AAPA; par [0005], lines 1-4)**.

In regards to **claim 4**, **AAPA** teaches the method of claim 3, wherein each media file source corresponds to a metadata source **(AAPA; par [0004], lines 1-2, 4)**, and wherein querying includes querying each of the metadata sources to identify the property for the media file **(AAPA; par [0005], lines 1-4)**.

Claims 10, 12, and 13 are rejected with the same rationale given for claims 1, 3, and 4, respectively.

In regards to **claim 16**, **AAPA** teaches the computer readable medium of claim 10, wherein retrieving instructions determine the metadata source from which to retrieve the property as a function of the property to be displayed **(AAPA; par [0005], lines 1-4)**.

14. **Claims 1-4 and 10-13** are rejected under 35 U.S.C. 102(e) as being anticipated by **Woodward et al.** (2003/0036948, hereinafter "Woodward").

In regards to **claim 1, Woodward** teaches a method for retrieving a property of a media file being played via a media player, wherein the media file is retrieved from one of a plurality of media file sources, which are prioritized, comprising:

- identifying a source of the media file **(Woodward; par [0019], lines 1-3; par [0023], lines 1-6)**; and
- displaying the property as defined by metadata of the identified source of the media file **(Woodward; par [0017], lines 21-30; par [0023], lines 1-6)**.

In regards to **claim 2, Woodward** teaches the method of claim 1, wherein retrieving includes retrieving the property defined by the source having the highest priority below the identified source of the media file when the identified source does not define the property **(Woodward; par [0020]; par [0023])**.

In regards to **claim 3, Woodward** teaches the method of claim 1 further including:

- querying each of the media file sources according to their priority to identify a property for the media file defined by the metadata of the source of the media file **(Woodward; par [0020]; par [0023])**; and
- retrieving the property as defined by the metadata of a first source in the priority identified as including metadata defining the property **(Woodward; par [0023])**.

In regards to **claim 4, Woodward** teaches the method of claim 3, wherein each media file source corresponds to a metadata source **(Woodward; par [0023])**, and wherein querying

includes querying each of the metadata sources to identify the property for the media file **(Woodward; par [0023])**.

Claims 10-13 are rejected with the same rationale given for claims 1-4, respectively.

In regards to **claim 16**, **Woodward** teaches the computer readable medium of claim 10, wherein retrieving instructions determine the metadata source from which to retrieve the property as a function of the property to be displayed **(Woodward; par [0017], lines 21-30; par [0023])**.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. **Claims 5-7 and 14-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward in view of Fowler et al.** (US 6,493,436, hereinafter "Fowler").

In regards to **claim 5, Woodward** teaches the method of claim 4, wherein the priority for querying each of the metadata sources is determined according to a predetermined importance assigned to each of the plurality of metadata sources **(Woodward; par [0022]; par [0023] – rules are predetermined and they are what dictate importance/method of querying sources)**. Woodward does not expressly teach the metadata source deemed most important being queried first, and the metadata source deemed least important being queried last. Woodward does not expressly teach a least important source being queried last. **Fowler** teaches prioritizing sources, checking/querying the most desirable, which is equivalent to being deemed the most important, source first, then the next most important, etc. until a suitable match is found or the last source has been checked/queried **(Fowler; col. 2, lines 14-35)**. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Woodward whereby the match probability rules of Woodward could be implemented using the priority rules taught by Fowler, as a way of finding the best match for the data **(Woodward, par [0022], par [0023]; Fowler, col. 2, lines 14-35)**.

In regards to **claim 6, Woodward and Fowler** teach the method of claim 5, wherein querying includes issuing a chain of calls to each metadata source, wherein a first call is to the metadata source deemed most important, and wherein a subsequent call is to the metadata source

deemed the next most important, and wherein a last call is to the metadata source deemed the least **(Fowler; col. 2, lines 14-35)**.

In regards to **claim 7, Woodward and Fowler** teach the method of claim 6, wherein the property to be displayed determines the metadata source from which to retrieve the property **(Woodward; par [0017], lines 21-30; par [0023])**.

Claims 14-15 are rejected with the same rationale given for claims 5-6, respectively.

18. **Claims 8 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over **AAPA in view of Cato et al.** (US 2003/0120928, hereinafter "Cato").

In regards to **claim 8, AAPA** teaches the method of claim 1. AAPA does not expressly teach retrieving metadata from the metadata source that returns the property in the least amount of time. **Cato** teaches, where there are multiple sources, retrieving the data from the source with the fastest internet connection, i.e. that would return the data the fastest **(Cato; par [0115])**. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method taught by AAPA with the feature taught by Cato, whereby the metadata would be retrieved from the source that is able to return the data the fastest in order to provide the most time efficient service.

Claim 17 is rejected with the same rationale given for claim 8.

19. **Claims 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **AAPA in view of Ramalay et al.** (US 2002/0138619, hereinafter "Ramalay"), **further in view of Eyal et al.** (US 2003/0033420, hereinafter "Eyal"), **further in view of Diamond et al.** (US 2002/0099694, hereinafter "Diamond"), **and further in view of Ijdens et al.** (US 2006/0090030, hereinafter "Ijdens").

In regards to **claim 9**, **AAPA** teaches the method of claim 1, wherein the metadata sources include a basic metadata source **(AAPA; par [0004], lines 1-2, 4)**. AAPA does not expressly teach the metadata sources including an ASX source, an WSX source, a media library source, a file header source, and a DRM source. **Ramalay** teaches an ASX file as a metadata source **(Ramalay; par [0042], par [0094])**. **Eyal** teaches playlists that are stored on a server module being a source of metadata **(Eyal; par [0110], par [0189])**. **Diamond** teaches metadata in a media file header **(Diamond; par [0026])**, and since the media file comprises a media library, metadata in a media file header also constitutes metadata from a media library source. **Ijdens** teaches DRM data as a type of metadata **(Ijdens; par [0017])**. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method described by AAPA with the various sources of metadata taught by Ramalay, Eyal, Diamond, and Ijdens in order to allow a user to display a requested media file and customize the media output based on the metadata retrieved from the metadata source **(Ramalay, par [0042], par [0094]; Eyal, par [0110], par [0189])**.

Claim 18 is rejected with the same rationale given for claim 9.

20. **Claims 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Woodward in view of Ramalay, further in view of Eyal, further in view of Diamond, and further in view of Ijdens**.

In regards to **claim 9**, **Woodward** teaches the method of claim 1, wherein the metadata sources include a basic metadata source and a media library source **(Woodward; par [0017], lines 21-30; par [0019]; par [0020]; par [0023], lines 1-6)**. Woodward does not expressly teach the metadata sources including an ASX source, an WSX source, a file header source, and a DRM source. **Ramalay** teaches an ASX file as a metadata source **(Ramalay; par [0042], par [0094])**. **Eyal** teaches playlists that are stored on a server module being a source of metadata **(Eyal; par [0110], par [0189])**. **Diamond** teaches metadata in a media file header **(Diamond; par [0026])**. **Ijdens** teaches DRM data as a type of metadata **(Ijdens; par [0017])**. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method described by Woodward with the various sources of metadata taught by Ramalay, Eyal, Diamond, and Ijdens in order to allow a user to display a requested media file and customize the media output based on the metadata retrieved from the metadata source **(Ramalay, par [0042], par [0094]; Eyal, par [0110], par [0189])**.

Claim 18 is rejected with the same rationale given for claim 9.

Conclusion

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **571-272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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June 21, 2006

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PRIMARY EXAMINER